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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/539,691	03/31/2000	Takahiro Yamamoto	P/1071-1009	1017

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EXAMINER

STAICOVICI, STEFAN

ART UNIT PAPER NUMBER

1732

DATE MAILED: 01/30/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Applicati n No.

09/539,691

Applicant(s)

YAMAMOTO ET AL.

Examiner

Stefan Staicovici

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 January 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☒ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.

Claim(s) objected to: None.

Claim(s) rejected: 1-10 and 15-18.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). 16,18.
10. ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statements (IDS) submitted on October 15, 2002 (Paper No. 16) and January 2, 2003 (Paper No. 18) were filed after the mailing date of the Final Rejection on October 2, 2002 (Paper No. 15). The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the Examiner has considered the information disclosure statement.

### ***Declaration***

2. The Declaration filed on January 2, 2003 under 37 CFR 1.131 has been considered but is ineffective to overcome the US Patent No. 6,172,330 reference.

3. The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the US Patent No. 6,172,330 reference. Specifically, under 37 C.F.R. 1.131(a), "the inventor of the subject matter of the rejected claim" needs to establish that the "invention of the subject matter of the rejected claim" is "prior to the effective date of the reference." Further, under 37 C.F.R. 1.131(b), the "showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference." Furthermore, 37 C.F.R. 1.131(b) goes on to state that original "exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence satisfactorily explained."

## **ATTACHMENT TO ADVISORY ACTION**

### ***Response to Amendment***

4. Applicants' After-Final amendment filed January 2, 2003 (Paper No. 19) will not be entered since the proposed amendments raise new issues that would require further consideration. Specifically, by amending the dependency of claims 8-10, subject matter is introduced in a combination that has not been previously presented and as such would require further consideration. Further, it should be noted that the proposed amendments are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.

### ***Response to Arguments***

5. Applicant's remarks filed January 2, 2003 (Paper No. 19) have been considered.

In response, as shown above, the proposed amendments raise new issues that would require further consideration.

Applicants argue that the Declaration under 37 C.F.R. 1.131 disqualifies the Yamamoto *et al.* (US Patent No. 6,172,330) as prior art (pages 4-5 of the After-Final amendment filed January 2, 2003). However, as shown above the declaration filed on January 2, 2003 under 37 CFR 1.131 has been considered but is ineffective to overcome the US Patent No. 6,172,330.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so

long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the teachings of Funami *et al.*('653) and White, Jr. ('143), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, Funami *et al.*('653) teach a laser process including, providing a laser beam (2e), splitting said laser by beam splitter (13) (forming a plurality of laser beams) and converging said plurality of laser beams (2f) using a convergent lenses (11) (see Figure 9 and col. 6, line 65 through col. 7, line 4). White, Jr. ('143) teaches a laser process including, providing a laser beam (1), splitting said laser beam into a plurality of beams (4) and reflecting said plurality of laser beams (4) off a mirror onto the part to be machined (see Figure 1 and col. 4, lines 23-34). Therefore, both references teach processing a plurality of laser beams by either a converging process (Funami *et al.*('653)) or a reflection process (White, Jr. ('143)). Therefore, it is submitted, that as a whole the method of operation is similar in nature.

Furthermore, it should be noted that even if Applicants read the teachings of Funami *et al.*('653) and White, Jr. ('143) as diverging in scope, MPEP § 2145(D) states that when

considering whether references teach away from each other, the prior art must be considered in its entirety, including disclosures that teach away from the claims (see MPEP § 2141.02). Further, under MPEP § 2143.01, “where the teachings of two or more prior art references conflict, the examiner must weigh the power of each reference to suggest solutions to one of ordinary skill in the art, considering the degree to which one reference might accurately discredit another. See In re Young, 927 F.2d 588, 18 USPQ2d 1089 (Fed. Cir. 1991).

Applicants argue that the “reflecting means of White, Jr. is fixed so as to reflect the plural laser beams perpendicular to the substrate” (see page 6 of the After-Final amendment filed January 2, 2003). However, in col. 6, lines 3-5, White, Jr. (‘143) specifically teaches “changing the position of the...reflecting means 5 so as to alter the position that the radiation irradiates the substrate or part.” Hence, it is submitted that the reflecting means of White, Jr. (‘143) are *not fixed* (emphasis added).

Applicants argue that White, Jr. (‘143) does not teach or suggest “changing reflection angles of the galvano-scan mirror” (see page 7 of the After-Final amendment filed January 2, 2003). However, it is submitted that because the position of the reflecting means is changed in order to change the direction (angle) at which the radiation impinges onto the substrate in White, Jr. (‘143), that it is the angle (direction) of the reflecting means that is changes requires changing the reflection angle of the reflecting means, hence resulting in changing the direction (angle) .

Applicants argue that White, Jr. (‘143) does not teach or suggest a “galvano-scan mirror” (see page 6 of the After-Final amendment filed January 2, 2003). Further, Applicants specifically request “to cite a reference...*that it was well known* at the time of the Applicants’ invention to include a galvano-scan mirror in a laser apparatus” (see page 7 of the After-Final amendment

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filed January 2, 2003). In response, as stated in the Final rejection mailed (October 2, 2002), White, Jr. teaches reflecting a plurality of laser beams (4) off a mirror onto the part to be machined (see Figure 1 and col. 4, lines 23-34) and also teaches the use of “any” reflecting type of mirror (col. 4, lines 30-33); as such it is submitted that White, Jr. (‘143) teaches a galvano-scan mirror. Further, it should be noted that under MPEP §2144.01, “[I]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom.”

Further, it should be noted that the teachings of White, Jr (‘143) were used for the same reason in both the Final Rejection (mailed October 2, 2002) and the Non-Final Rejection (mailed January 30, 2002). Furthermore, it should be noted that Applicants did not traverse the teachings of White, Jr (‘143) made in the Non-Final Rejection (mailed January 30, 2002). Although a “well known “ statement was not made, as implied by Applicants on page 7 of the After-Final amendment filed January 2, 2003, Applicants should be aware that under MPEP §2144.03, if “applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art.” However, in order to address Applicants’ concern, it should be noted that the teachings of JP 62-13120, which was submitted with the IDS filed January 2, 2003 (Paper No. 18), show a galvano-scan mirror with a laser apparatus.

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***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefan Staicovici, Ph.D. whose telephone number is (703) 305-0396. The examiner can normally be reached on Monday-Friday 8:00 AM to 5:30 PM and alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard D. Crispino, can be reached at (703) 308-3853. The fax phone number for this Group is (703) 305-7718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Stefan Staicovici, PhD



Primary Examiner

1/29/03

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January 29, 2003